REMARKS

This Restriction is respectfully traversed. Three claims (claims 48-50), are currently pending in the present application (prior to entry of the present amendment). Claim 49 presents a Markush-type grouping and provides for certain exemplary methods of identifying a decrease in the function of a 101P3A11 protein. The Applicants also respectfully note that new claims 51 and 52 also present proper Markush-type groupings which fall within the scope of the present traversal and/or Group election. The present restriction requirement has identified eight groups of purportedly patentably distinct inventions as contained within the three pending claims. All of these Groups are characterized by the Office as classified in the same class (435) and subclass (4). The Office has required election of one of these eight groups to proceed with examination of the subject application. Accordingly, the Office is presently requiring that the Applicant's break apart and redraft the invention set forth in the claims. The Applicants respectfully assert that the present requirement is improper in view of the present invention and the claims presented.

An applicant for a patent has the "right to define what he regards as his invention as he chooses, so long as his definition is distinct as required by the second paragraph of § 112, and supported by an enabling disclosure, as required by the first paragraph of § 112." *In re Harnisch*, 206 USPQ 300, 305 (C.C.P.A. 1980). "[I]f . . . a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim." *In re Weber*, 198 USPQ 328, 331 (Fed. Cir. 1978). Accordingly, as acknowledged in *Ex parte Holt*, the requirement that a singular claim be fragmented into multiple parts is tantamount to a rejection of that claim. See *Ex parte Holt*, 214 USPQ 381, 383 (Bd. Pat. App & Int. 1982) (Indicating that regardless of the language used by an Examiner to refer to a singular claim as subject to a restriction or rejection under § 121 (due to a purportedly improper Markush claim), "the refusal to examine a claim is, in effect, a rejection of that claim." *Id.*); *see also In re Haas*, 198 USPQ 334 (C.C.P.A. 1978) (determining that § 121 could not be

used as the basis for rejecting a single claim or compelling its replacement by a plurality of narrower claims (i.e., restriction within a particular claim) before examination on the merits.).

Groups II through VIII appear to be directed to varying aspects of claim 49. Group I is also directed to aspects of claim 49, in that a decrease in production of 101P3A11 protein may be identified through the one or more methods of claim 49. In contrast to the reasoning of the present restriction requirement, function and production of 101P3A11 are not mutually exclusive as presented in claims 48-50. Moreover, the manner in which a function, production or status is evaluated is not dispositive of the invention as set forth in the specification and claimed, e.g., in the independent claims. Thus, a restriction on this basis is respectfully asserted to be improper.

The applicants submit that the present claims are proper and need not be subject to a Restriction. Moreover, the Applicants assert that since all eight Groups are classified in the same class and subclass, that no undue search burden is involved in the examination of these three claims.

The Office has asserted, without elaboration, that Groups I-VIII "are distinct from each other because they differ at least in objectives, method steps, reagents and/or dosages, and/or schedules used, response variables and criteria for success." These groups, however, have common similarities in that each of these groups contains an aspect that may be utilized to identify: (1) a decrease in the function of 101P3A11 protein, and (2) an agent that decreases the function of 101P3A11 protein. Moreover, these groups contain aspects that may be equally adept at identifying: (1) a decrease in the production of 101P3A11 protein, and (2) an agent that decreases the production of 101P3A11 protein. Claim 49, then, presents a proper Markush grouping which is "not repugnant to the principles of scientific classification." *In re Harnisch*, 206 USPQ at 305.

Accordingly, the present restriction of the subject matter of claims 48-50 into eight groups is respectfully asserted to be improper in light of current case law. As is well accepted, the Applicants are entitled to be their own lexicographers and claim their invention as it is described and understood. Moreover, the Applicants assert that claim 49, in connection with

claims 48 and 50, fulfills the requirements of 35 U.S.C. § 112 and may be examined as provided. A forced division in these claims, in accordance with the present requirement, would present a situation where the claims may not adequately define the present invention as presently understood. Accordingly, if the present restriction requirement is maintained, the present claims will not be examined on their merits. Thus, the Applicants respectfully traverse the present restriction requirement as it applies to Groups I-VIII.

The claims have been amended in conformance with the present restriction requirement and to clarify their intended scope. Amended claim 48 is supported throughout the specification and claims as originally filed. New claim 51 represents claim 49 in re-written form to clarify the intended scope of the claims. New claims 51 and 52 are supported by the specification and claims as filed, for example, see specification at pages 47-48. Prosecution is facilitated by the clarified claim set. No new matter has been added and entry of the amendment is respectfully requested.

The Office has provided that Group I is directed to a method to identify an agent that decreases the production of 101P3A11 protein. Respectfully, amended claim 48 is within the scope of this Group designation.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE".

Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

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Respectfully submitted,

Dated: February 18, 2003 By: _____

David Devernoe
Registration No. 50,128

Morrison & Foerster LLP
3811 Valley Centre Drive
Suite 500
San Diego, California 92130-2332
Telephone: (858) 720-7943
Facsimile: (858) 720-5125

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Please amend claim 48 as follows:

48. (Amended) A method to identify an agent that decreases the [function or production] expression status of 101P3A11 protein, which method comprises:

providing cells that express 101P3A11 protein;

contacting a first sample of said cells with a candidate compound under conditions wherein the [function or production] expression status of the 101P3A11 protein is observable;

observing said contacted cells for at least one property characteristic of said [function or production] expression status of said 101P3A11 protein;

observing a second sample of said cells which have not been contacted with said candidate compound for said at least one property characteristic of the [function or production] expression status of the 101P3A11 protein;

comparing the observed property in said first and second sample;

whereby a diminution in the property exhibited by said first sample as compared to said second sample identifies said compound as an agent that decreases the [function or production] expression status of 101P3A11 protein.